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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

915-416

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on April 17, 2006

Signature Deborah J. Clark

Typed or printed name Deborah J. Clark

Application Number

10/041,702

Filed

January 4, 2002

First Named Inventor

MOLNAR et al

Art Unit

2686

Examiner

Khawar IQBAL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Keith R. Obert

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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April 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.



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Docket No. 915-416
Serial No. 10/041,702

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Valeria MOLNAR et al.

Serial No.: **10/041,702**

Examiner: **Khawar IQBAL**

Filed: **January 4, 2002**

Group Art Unit: **2686**

For: **METHOD FOR THE RESTRICTION OF A MESSAGE SERVICE**

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Request for Review is filed in response to the final Office Action of December 16, 2005.

CERTIFICATE OF MAILING

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Deborah J. Clark
Deborah J. Clark
Dated: April 17, 2006

REMARKS

Applicant respectfully requests review of the final rejection of December 16, 2005 in light of the following remarks. The review is requested because the Office has failed to show proper motivation to combine the teachings Alperovich et al. (U.S. Patent No. 6,101,393) with the teachings of Vudali et al. (U.S. Patent No. 6,151,499). This request for review is being submitted with a Notice of Appeal.

Independent claim 1 recites a method including a step of keeping a record containing information about certain addresses with which a communication is not allowed, wherein the record is kept in a switching center. Alperovich teaches two lists stored in a Home Location Register, but fails to teach storing the lists in a switching center. See Alperovich column 2, lines 3-8; Dec. 16, 2005 final Office Action, page 3. Vudali teaches a Mobile Switching Center. See Vudali column 3, lines 1-3. The Office asserts that it would be obvious to modify the teachings of Alperovich by adding a mobile switching center, and that it would be obvious to integrate the functionality of a Home Location Register into a Mobile Switching Center. See Dec. 16, 2005 final Office Action, page 5. However, applicant respectfully submits that it is not obvious to incorporate a record containing information about certain addresses with which a communication is not allowed into a switching center, as recited in claim 1.

First, the functionality obtained by locating the record in the Home Location Register is different from the functionality obtained by locating the record in the Mobile Switching Center. It is well known in the art that the Home Location Register is not involved during message transmission in the mobile originating case, unlike the Mobile Switching Center which is involved. Therefore, the record cannot be interrogated when located in a Home Location Register to determine if a message from the sender is not allowed. The present invention as recited in claim 1 has the advantage that it is possible to restrict the sending of messages from a mobile station. See Applicant's Response of Jan. 31, 2005 page 2, paragraph 2. This is effectuated by having the record located in the switching center, as recited in claim 1. As discussed above, in the mobile originated case the Home Location Register is not involved, and therefore Home Location Register-based message restriction as taught by Alperovich does not cover restricting the sending of messages from a

mobile station. It is well known in the art the art that the Home Location Register is not interrogated with respect to the sender of a message. Therefore, the functionality of a Home Location Register taught in Alperovich does not cover restricting the sending of messages from a mobile terminal, and as such the functionality realized by locating the record in the switching center cannot be suggested by the prior art. See Alperovich column 5, lines 6-10 (screening mechanism preferably includes a screening application and two lists within the HLR database, which are used to determine whether to allow delivery of an SMS message). Without recognition of this functionality in the cited prior art, there is no motivation to locate a record containing information about certain addresses with which a message communication is not allowed in a switching center, as claimed in claim 1.

Second, the cited references (Alperovich and Vudali) do not provide motivation to locate the record in the Mobile Switching Center. Instead, at most, all that is disclosed is co-locating the Home Location Register with the Mobile Switching Center. Therefore, the record is still located in the Home Location Register, and bound by the functionality of the Home Location Register. The location of the record containing information about certain addresses with which a message communication is not allowed in a switching center is what effectuates the advantages of the present invention claimed in claim 1. A suggestion to combine a Home Location Register in a Mobile Switching Center is not sufficient to provide motivation to locate a record in a switching center, as claimed in claim 1. Therefore, there is no suggestion or motivation to combine a record apart from a Home Location Register in a switching center.

For the same reasons discussed above in relation to keeping a record in a switching center, there is also no motivation to perform a decision step and a preventing step in a switching center. See Applicant's Response of Nov. 8, 2005 page 3, paragraph 4.

For at least these reasons, there is no motivation to combine a record with a switching center from either the level of skill in the art or from the cited prior art references. See MPEP § 2143.01. Instead, the motivation to combine these features is based upon the applicant's own disclosure, and is the result of impermissible hindsight. See MPEP § 706.02(j). Finally, all claim limitations must be taught or

suggested by the prior art. See MPEP § 2143.03. Since Alperovich and Vudali fail to at least teach or suggest a record containing information about certain addresses with which a message communication is not allowed kept in a switching center either alone or in combination, claim 1 is patentable over the cited references.

Independent claims 7 and 11 also contain the limitation of a record kept in a switching center, and for the reasons discussed above in relation to claim 1 are also patentable.

Dependent claims 2-6, 8-10 and 12-14 all depend directly or indirectly from an independent claim, and are patentable at least in view of their dependencies.

Therefore, applicant respectfully requests review and withdrawal of the final rejection in light of the above arguments.

Respectfully submitted,



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